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 Attorneys for Defendant/Counter-Plaintiff,  
 KEATING DENTAL ARTS, INC.

IN THE UNITED STATES DISTRICT COURT  
 FOR THE CENTRAL DISTRICT OF CALIFORNIA  
 SOUTHERN DIVISION

JAMES R. GLIDEWELL DENTAL  
 CEAMICS, INC. dba GLIDEWELL  
 LABORATORIES,

Plaintiff,

v.

KEATING DENTAL ARTS, INC.

Defendant.

AND RELATED COUNTERCLAIMS.

Civil Action No.  
 SACV11-01309-DOC(ANx)

**DEFENDANT'S EXPERT  
 LORI BOATRIGHT'S  
 REBUTTAL REPORT TO  
 THE REPORT OF DAVID J.  
 FRANKLYN**

Honorable David O. Carter

1                   **I. PROFESSIONAL AND EDUCATIONAL BACKGROUND**

2           1.     I am the Chair of the Trademark Practice Group at the intellectual  
3 property law firm BLAKELY SOKOLOFF TAYLOR & ZAFMAN, LLP  
4 (“BSTZ” or “Firm”). The Trademark Group, based in Los Angeles, handles all  
5 trademark-related work for the Firm’s six office (Los Angeles, Silicon Valley,  
6 Orange County, Portland, Seattle, and Denver). I joined BSTZ in 1988 and  
7 became a partner of the Firm in 1993. After working to develop the trademark  
8 practice, I founded the Trademark Practice Group for the Firm in 1996; I have  
9 served as Chair of the Trademark Practice Group since that time.

10          2.     I practice all aspects of trademarks and unfair competition law,  
11 including trademark-related matters such as publicity rights, emerging issues  
12 surrounding social media and advertising. My practice focuses primarily on  
13 branding-related transactional work and client counseling, with trademark  
14 protection at its root. I provide advice and offer strategic guidance during mark  
15 selection and clearance, during filing and prosecution (domestic and  
16 international), and offer counsel as to overall protection strategies. I handle  
17 analysis, growth and management of domestic and international trademark  
18 portfolios, prepare IP contracts, and conduct/manage due diligence matters. I  
19 actively engage in enforcement actions, from demand stage through negotiation  
20 and settlement; I represent clients in proceedings at the Trademark Trial and  
21 Appeal Board (“TTAB”) and in Federal Court.

22          3.     While working at BSTZ, I have filed and prosecuted well over  
23 2,000 U.S. applications for registration. The U.S. Trademark online database  
24 reflects that I am the identified Attorney of Record for 2,079 trademark  
25 applications – however, I do file and prosecute applications on behalf of clients  
26 who choose to have in-house counsel identified on the site; additionally, for  
27 several years, senior BSTZ attorney were identified despite that I directed, filed,  
28

1 and prosecuted applications. Although I do not keep close records, I would  
2 estimate the number of applications filed/prosecuted to be roughly 2,500 –  
3 3,000 applications. Additionally, I have been Attorney of Record in over 100  
4 TTAB proceedings (ex parte appeals, oppositions and cancellation proceedings).  
5 I have been hired as an expert in trademark law for a number of cases and have  
6 been deposed but none reached trial. They include *Optimal Pets, Inc. v. Nutri-*  
7 *Vet, LLC et al.*, EDCV 08-1795 SGL (C.D. Cal. 2008); *Artists Management*  
8 *Group, LLC v. Advantage Marketing Group, Inc.*, CV-01-4890 (C.D. Cal.  
9 2001); and *SG Services, Inc. v. God's Girls, LLC*, CV01526 (OR-Portland  
10 2005); *SG Services, Inc. v. God's Girls, LLC*, 2:08-CV-01873-ODW-JWJ (C.D.  
11 Cal. 2008)

12 4. Prior to joining BSTZ, I was a Trademark Examining Attorney at  
13 the U.S. Patent & Trademark Office (“USPTO”) from January 1987 through  
14 November 1988. I received formal training from the USPTO by way of  
15 lectures, readings and assignments; I worked closely with a supervisory attorney  
16 for the first six months of my employment and progressed such that I timely  
17 received “Full Signatory Authority” to act as an independent Trademark  
18 Examining Attorney.

19 5. As an Examining Attorney, I examined over 2,500 trademark  
20 applications for registration and handled the prosecution of each application  
21 (“cases”) from examination through registration/abandonment. In that capacity,  
22 I reviewed trademark and service mark applications for suitability for trademark  
23 registration – including, without limitation, I conducted trademark and service  
24 mark searches for likelihood of confusion determinations, conducted review of  
25 available information on issues of meaning/nature (whether marks were  
26 descriptive/generic, were primarily merely surnames, or were geographically  
27 descriptive, for example), examined the applications for administrative issues  
28 (“informalities”) and for substantive issues which mandated issuance of “refusal

1 to register.” As part of my duties, I prepared and issued formal Office Actions  
2 following examination and determination (with accompanying legal  
3 authority/explanation), evaluated “Responses to Office Action” filed on behalf  
4 of Applicants, and in appropriate instances, issued “final refusal to register”  
5 (with accompanying legal authority/explanation). Additionally, I prepared and  
6 managed appeals and conducted oral argument at Trademark Trial and Appeal  
7 Board (TTAB).

8 6. As an Examining Attorney I received the highest rating offered  
9 during annual review for both years of service and was noted as having  
10 surpassed the productivity requirement (based on numbers of cases successfully  
11 examined) while receiving an “Excellent” rating for substantive content –  
12 referred to as being at “110% Goal”. I was selected for “TTAB assignment” (a  
13 coveted position) by the then-members of the TTAB and interlocutory  
14 attorneys.

15 7. In addition to the formal training, informal training as to the U.S.  
16 Trademark Office “viewpoint” on subjective issues continued throughout my  
17 tenure (and continues today) in that Examining Attorneys discuss with one  
18 another the difficult or “gray area” matters and all were keen to meet the Case  
19 Review procedures within each Law Office or the several additional levels of  
20 review by Managers and Division Directors.

21 8. Given the subjective nature of such issues as “descriptiveness” and  
22 as to “borderline” likelihood of confusion determinations, Examining Attorneys  
23 come to see determinations with some uniformity, particularly since many  
24 TTAB members previously worked as Trademark Examining Attorney ranks,  
25 and the TTAB opinions were regularly distributed and discussed. Working as  
26 an Examining Attorney, attending legal lecture series, reading/assisting in  
27 formulation of “Examination Guides,” and daily review/study of the Trademark  
28 Manual of Examining Procedure (“TMEP”) all contributes to one’s

1 understanding of the U.S. Trademark Office's practices and procedures, the  
2 nuances of examination, and a keen understanding of "registrability."

3 9. Even now, I am in contact with U.S. Trademark Office Examining  
4 Attorneys with whom I worked, and I have hired at eight former Trademark  
5 Examining Attorney to work within the BSTZ Trademark Practice Group, as  
6 recently as three years ago, such that the understanding of the "Examining  
7 Attorney's viewpoint" remains current within the Group.

8 10. Prior to beginning work as a Trademark Examining Attorney, I  
9 worked for over a year at the Law Office of Fred Kugler whose office was  
10 adjacent to building which then-housed the U.S. Trademark Office. A sole  
11 practitioner who had at one point been the Acting Director for the Trademark  
12 Office, Mr. Kugler offered training in all manners of trademark search issues. I  
13 conducted trademark searches (through the "old school" hand review of "shoes"  
14 at the U.S.P.T.O. Trademark Library), updated in-house common law sources;  
15 analyzed full national searches from vendors (such as Thomson & Thomson) for  
16 corporate clients and provided counsel to law firms, conducted "use"  
17 investigations, and wrote trademark availability opinions.

18 11. I graduated from the University of Missouri School of Law in 1984  
19 where I was named a Director of the Board of Advocates and received the Top  
20 Prize in Advocacy following winning the school-wide competition both my  
21 second and third years (which allowed me to represent the University of  
22 Missouri at the Regional National Moot Court tournaments). After spending a  
23 year in a general litigation firm, I have practiced strictly in the area of trademark  
24 law since 1985, some twenty-seven years. From my tenure at the U.S.  
25 Trademark Office, a significant portion of my practice has been in trademark  
26 protection and prosecution – the London-based World Trademark Review in  
27 their "Top 1000 Trademark Attorneys Around the World" identified me as a  
28 notable U.S. attorney, specifically in the area of "Trademark Prosecution and

1 Strategy.” Over the course of my career, I have conducted thousands of  
 2 clearance searches, conducted thousands of web searches on the issue of  
 3 descriptiveness, and filed 2,500 – 3,000 U.S. trademark/service mark  
 4 applications and prosecuted most through natural conclusion (registration or  
 5 abandonment).

6 12. The BSTZ Trademark Practice Group has been recognized as a  
 7 “Top Ten” firm in connection with the number of U.S. trademark filings (and  
 8 first in the Los Angeles area, the nation’s second leading market) (source:  
 9 NameProtect®). The rank has changed each year but BSTZ is within the Top  
 10 25 nationwide in filing numbers despite not having a significant foreign filing  
 11 practice (source: Intellectual Property Today, 2011).

12 13. I generally perform a clearance search and a web “meaning” search  
 13 for every mark for which I file an application and for many marks for which  
 14 applications are never filed. Having spent a year working solely in trademark  
 15 searching, and two years as a U.S. Trademark Examining Attorney, and twenty-  
 16 seven years practicing trademark law, I am confident of my legal knowledge of  
 17 U.S. trademark law and of the nature and nuance of trademark prosecution in  
 18 the United States; too, I am confident in my understanding of and analysis of  
 19 trademark likelihood of confusion and related infringement determinations.

20 14. A true and correct copy of my resume is attached as Exhibit A to  
 21 this report.

22 15. I am being compensated for my work in this matter at my  
 23 customary rate of \$625 per hour for time spent reviewing materials, preparing  
 24 this report, and testifying at deposition and trial, if necessary.

## 25 **II. SUMMARY OF OPINION**

26 16. I have reviewed relevant documents, including the Expert Report  
 27 of David J. Franklyn on behalf of Plaintiff/Counter-Defendant James R.  
 28 Glidewell Dental Ceramics, Inc., DBA Glidewell Laboratories (“Glidewell” or

1 “Plaintiff”), certain pleadings in *Glidewell v. Defendant Keating Dental Arts,*  
2 *Inc.* (“Keating” or “Defendant”), conducted web reviews of the words  
3 BRUXER, BRUXZIR and BRUXISM, conducted U.S. Trademark Office  
4 searches including review of prosecution histories of relevant  
5 applications/registrations, and reviewed full national (comprehensive) searches  
6 of the words BRUXER and BRUXZIR, among other materials as identified  
7 herein.

8 17. I conducted a review of the alleged mark BRUXZIR and KDZ  
9 BRUXER as if I were the Examining Attorney at the U.S.P.T.O., and I  
10 examined the prosecution histories of the original registration and the second  
11 application to determine what actions were taken by the Examining Attorneys in  
12 both cases. I conducted reviews of third party applications/registrations which  
13 included BRUX-formatives in the mark and in the “disclaimers” of such  
14 applications/registrations and reviewed the identifications of goods for relevant  
15 information.

16 18. It is my opinion that (a) Glidewell’s alleged mark is generic and/or  
17 highly descriptive and is therefore not entitled to registration as a trademark;  
18 and (b) there is no likelihood of confusion as between Glidewell’s alleged mark  
19 BRUXZIR and Keating’s use of BRUXER as a generic term (both as it appears  
20 on packaging for KDZ Bruxer, in advertising, and as it was presented in  
21 application form as KDZ BRUXER to the U.S.P.T.O.). Before reviewing the  
22 factors set forth in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979)  
23 there were two “preliminary” considerations, from my perspective which  
24 affected the Sleekcraft factors and, ultimately, the determination of a likelihood  
25 of confusion. First, I needed to determine whether Glidewell has any valid  
26 trademark rights at all in BRUXZIR, and, if so, what ambit of protection is to be  
27 afforded. The second step related directly to the other side of the equation,  
28 namely whether the generic term “bruxer” as used by Keating in the mark KDZ

1 BRUXER (and by other third parties), can be a valid basis for a claim of  
2 infringement.

3 19. Ordinarily, the use of a generic term necessary to market a product  
4 cannot be the subject of a confusion claim – and for obvious reasons. Generic  
5 terms are necessary for the marketplace; they are words used to connote that  
6 which is being sold or the intended user of the product (legal argument to  
7 follow). “Genericide” occurs when perfectly good trademarks are not properly  
8 policed such that over time they BECOME the apt name of the goods over time  
9 and are used by the relevant public to refer to the product genus, such as  
10 ASPIRIN, ESCALATOR, and CELLOPHANE. During my tenure as an  
11 Examining Attorney, I refused registration to the mark RANCH for salad  
12 dressing despite the fact that the Applicant owned the mark (and multiple  
13 registrations for) HIDDEN VALLEY RANCH without a disclaimer of “Ranch”  
14 in such registrations. Of course, over time, “RANCH” had become the  
15 shortened name for their “buttermilk” dressing and the word had lost its  
16 trademark significance. Still, the refusal was valid as I provided clear evidence  
17 that RANCH was generic for salad dressing (the refusal was not appealed thus  
18 leaving the applicant free to refile).

19 20. In this matter, however, “bruxers” have been known for decades by  
20 such term – bruxers are those who suffer from bruxism (teeth grinding). The  
21 term “bruxism” originated likely in the early 1900s but first appeared in medical  
22 literature in the early 1930s (from Greek *brychein* or *brukhein* to gnash the teeth  
23 + ism”; Merriam-Webster Dictionary; Oxford U.S. and British Dictionary). A  
24 search of “bruxer” on the web using the Google search engine shows 32,800  
25 search “results.” The Wikipedia entry (2nd listed) for “bruxism” includes use of  
26 “bruxer” to connote a person suffering from bruxism (“... some bruxers clench  
27 and grind front teeth only”). Even limiting the search to “bruxer teeth,” the  
28 web search resulted in finding 24,800 “hits.”



1           21. A search of “bruxer” in the “Google Books” section (searching  
2 contents of publications) included irrelevant findings, so the search was then  
3 limited to “bruxer” with any of the terms “dental OR sleep OR tmj OR teeth”.  
4 With this refinement in place, “bruxer” appeared in 1,670 books.

5           22. Most of the books revealed are geared for medical/dental  
6 professionals, but too, “bruxers” are identified (and described) in a variety of  
7 books geared for consumers, such as *A Consumer Guide to Dentistry* by Gordon  
8 J. Christensen (2001); *Sleep Disorders for Dummies* (from the well-known  
9 *Dummies* series) by Max Hirshkowitz and Patricia B. Smith (2004); *The Oral*  
10 *Report: The Consumer's Common-Sense Guide to Better Dental Care* by Jerry  
11 F. and Mary Jane Tainter (1989); *How to Save Your Teeth and Your Money: A*  
12 *Consumer's Guide* by Melvin and Elaine Denholtz (1977); *The UC Berkeley*  
13 *Wellness Self-Care Handbook* by John Edward Swartzberg and Sheldon Margen  
14 (1998); *Nothin' Personal Doc, I Hate Dentist – Feel Good Guide to Going to*  
15 *the Dentist* by McHenry Lee, Joleen Jackson and Vicki J. Audette (1999); *Total*  
16 *Health for Men* by Neil Wertheimer (1998); *Symptoms & Solutions – How to*  
17 *Tell When Your Ailments Are Misdiagnosed and What To Do About It* by Jay A.  
18 Goldstein (1993); *Refresh Life: Oral Health and Adding Years to Your Life* by  
19 Dr. Dan Sindelar (2011). Additionally, “bruxers” are identified in a relevant  
20 fashion in at least one novel, *Call Me Kick!* By John Osander (2002).

21           23. Glidewell’s own website informs the public that its products are  
22 designed “for bruxers” at [http://www.glidewelldental.com/dentist/services/all-](http://www.glidewelldental.com/dentist/services/all-ceramics-bruxzir.aspx)  
23 [ceramics-bruxzir.aspx](http://www.glidewelldental.com/dentist/services/all-ceramics-bruxzir.aspx):

24           BruxZir® Solid Zirconia is a monolithic zirconia crown, bridge, screw-  
25 retained implant crown, inlay or onlay with no porcelain overlay. More  
26 brawn than beauty, you'll be impressed by the esthetics of BruxZir when  
27 prescribed instead of metal occlusal PFMs and cast gold restorations.  
28           BruxZir, because of its chip-proof durability, **is an ideal solution for**

1        **bruxers who have destroyed their natural teeth** or existing dental  
2        restorations. (Emphasis added).

3        24. On its blog devoted to the BRUXZIR product, at  
4        <http://blog.bruxzir.com/>, Glidewell touts:

5        When we launched BruxZir Solid Zirconia crowns & bridges in 2009, our  
6        intention was to provide a monolithic zirconia restoration **indicated for**  
7        **bruxers and grinders** as an esthetic alternative to posterior metal  
8        occlusal PFMs and full-cast metal restorations. The result was a material  
9        we said was "More Brawn than Beauty." (Emphasis added).

10       Note: to verify this was not a 3rd party blog comment, see "Posted by  
11       Glidewell Laboratories at 10/28/2011 7:25 AM."

12       25. The Glidewell site does not only mention "bruxers" in connection  
13       with its BRUXZIR product – so too do they identify "bruxers" as ones who  
14       could benefit from a "transition" crown before the final crown is ready to be  
15       seated. As noted at [www.glidewelldental.com/lab/services/transition.aspx](http://www.glidewelldental.com/lab/services/transition.aspx):

16       Transition Crowns & Bridges® are a treatment option that fills the void  
17       between custom-made temporaries and the final fixed restoration.  
18       Whether prescribed for short-term or long-term use, this restorative  
19       option offers an inexpensive interim solution that lasts 10 times longer  
20       than traditional lab provisionals. They are often **indicated in**  
21       **compromised cases presented by bruxers, periodontal therapy, the**  
22       **elderly or seriously ill**, and dental implants. (Emphasis added).

23       26. In offerings for restoration, a particular kind of ceramic restoration  
24       is likewise advertised for "bruxers"

25       <http://www.glidewelldental.com/lab/services/>:

26       Biocompatible and corrosion resistant, Captek is reinforced with particles  
27       of platinum and palladium, which provides increased strength and  
28       exhibits low plaque retention in clinical testing. Captek is specially

1       **designed to meet the needed strength for bruxers, long-span bridges,**  
2       **and implants.** (Emphasis added).

3       27. As used by Glidewell in videos in which the spelling is unclear to  
4 the viewer, BRUXZIR is pronounced by Glidewell as the phonetic equivalent of  
5 “bruxer” such that they are indistinguishable. Further, Glidewell uses it as a  
6 noun which is evidence of genericness – and likewise Glidewell endorses its use  
7 in the plural, further evidence of genericness (“this Bruxzir is 100% zirconia”  
8 and “one question I get about Bruxzirs is. . .” Videos promoting such  
9 pronunciations and in the form of generic terms are many; they can be found on  
10 Glidewell’s site and broadcast on YouTube. In particular (incomplete) we note  
11 to see/listen:

- 12       • <http://www.youtube.com/watch?v=1FpFVrBSHMY>
- 13       • [http://www.youtube.com/watch?v=\\_zsOdOxoeNY](http://www.youtube.com/watch?v=_zsOdOxoeNY)
- 14       • [http://www.youtube.com/watch?v=IqrbNy3\\_OsA&feature=relmfu](http://www.youtube.com/watch?v=IqrbNy3_OsA&feature=relmfu)
- 15       • [http://www.youtube.com/watch?v=tUpp\\_DOY4Vw](http://www.youtube.com/watch?v=tUpp_DOY4Vw)
- 16       • <http://www.youtube.com/watch?v=qPaoX0zAR-A/>

17       28. In a Glidewell video (titled “Clinical Case: The Pursuit of  
18 Bruxzir® Esthetics”) the narrator, a practicing dentist who appears in many  
19 Glidewell videos, says “I always like to show you what you can do with  
20 Bruxzir, um, in the anterior – and so this would be for somebody who is [sic]  
21 got a lot of wear on their teeth for example or has broken previous restorations.”

22       29. It seems as though the narrator is about to reference the patient as a  
23 bruxer – certainly he is about to use a noun in that he says “somebody who is. .  
24 .” – but then awkwardly finishes that the Bruxzir would be “for someone who is  
25 got a lot of wear.” Since Glidewell has adopted the phonetically equivalent  
26 Bruxzir as a mark, unlike in print where the spelling is apparent and notable, the  
27 speaker must avoid use of “bruxer” – not to do so would have him essentially  
28 saying he would “like to show you what you can do with BRUXER in the

1 anterior – this would be for somebody who is a bruxer.” See  
2 <http://www.youtube.com/watch?v=GzKZbiOXio0>.

3 30. In a Glidewell video for the consumer (titled “Bruxzir® Solid  
4 Zirconia Patient Education”), the narrator says:

5 Because Bruxzir restorations have no porcelain overlay, they are more  
6 resistant to chipping, cracking, or breaking in the mouth. This makes  
7 Bruxzir crowns and bridges ideal for anyone including bruxers and  
8 grinders who have broken their natural teeth or porcelain restorations in  
9 the past.

10 See [http://www.youtube.com/watch?v=D4taHSdbP\\_w](http://www.youtube.com/watch?v=D4taHSdbP_w) (from 0:20 – 0:36 on  
11 time stamp).

12 31. In creating the above transcript, I was doing Glidewell the service  
13 of identifying “Bruxzir” where I supposed they wished it to be placed.  
14 Otherwise the transcript would read as it sounded:

15 Because bruxer restorations have no porcelain overlay, they are more  
16 resistant to chipping, cracking, or breaking in the mouth. This makes  
17 bruxer crowns and bridges ideal for anyone including bruxers and  
18 grinders who have broken their natural teeth or porcelain restorations in  
19 the past.

20 See [http://www.youtube.com/watch?v=D4taHSdbP\\_w](http://www.youtube.com/watch?v=D4taHSdbP_w) (from 0:20 – 0:36 on  
21 time stamp).

22 32. One can also listen to/watch videos in which third party dental  
23 professionals pronounce BRUXZIR and “bruxer” identically in describing  
24 Glidewell products to the public:  
25 <http://www.youtube.com/watch?v=MXW6WCvV0QQ&feature=related>.

26 33. With the web, we are able to find evidence that was unavailable  
27 years ago, such as an independently produced video (unrelated to Glidewell or  
28 Keating) by R-Dent Laboratory. In a video entitled “How to Adjust the Bruxzir

1 Crown,” Bob Hewitt, a self-identified retired dentist of forty years and a  
2 technical support employee of R-Dent Labs explains: “Today I’d like to talk to  
3 you about adjusting the full contour zirconia crown. Some laboratories call  
4 it the bruxer crown. We call it the R-Brux crown.” Note: “R-Brux crown” is  
5 identified as the R-Dent Laboratories mark for its solid-zirconia crown. The  
6 video is found at <http://www.youtube.com/watch?v=sTTwU1LDvjU>.

7 34. Glidewell was able to secure registration (registration should not  
8 have been issued – see below – no web search was conducted by the Examining  
9 Attorney and no inquiry as to meaning was made) for BRUXZIR despite it  
10 being phonetically identical to the generic term for the intended user, bruxer,  
11 and despite Glidewell using it generically.

12 35. A parallel can be drawn to the “ranch dressing” refusal against  
13 Hidden Valley Ranch (HV Food Products) noted previously (application for  
14 RANCH was refused registration on the basis of generic/highly descriptive).  
15 The refusal was issued/made final in 1988. A search of the U.S.P.T.O. website  
16 revealed that the U.S.P.T.O. first allowed a third party to register a mark in  
17 which “RANCH” was included but disclaimed (e.g. GARDEN Ranch Salad  
18 Dressing, with a disclaimer of RANCH) occurred in 1989. Using this purely as  
19 an example, had HV Food been granted a registration for “RANCH” it may  
20 have empowered HV Food Products to prevent others from using and/or  
21 registering product names which include “ranch” as a generic term (e.g.  
22 FIESTA Ranch Dressing or FARM KITCHEN Ranch Dressing) – at least until  
23 a competitor sought cancellation of the registration on the basis that “Ranch”  
24 was so highly descriptive to fail to function as a mark and/or generic. **It should**  
25 **be noted that this is a hypothetical and that I have no knowledge of any**  
26 **such bad intent on the part of HV Food.** By 1989, “ranch dressing” was  
27 pervasive and had become the genus/apt name for buttermilk salad dressing;  
28 every salad dressing company had the right to use the word “ranch” to describe

1 their dressing. Had HV Food been allowed to “corner the market” on the  
2 NAME under the pretense of it being a MARK, this would have given HV Food  
3 a significant but wrongful competitive advantage akin to manipulating  
4 trademark law to work as a patent. Obviously, no company could have been  
5 prevented from *making* or selling ranch dressing but marketing it without being  
6 able to say “ranch” would have had serious repercussions – just as Glidewell  
7 seeks in this case.

8 36. Glidewell should not be the only company allowed to use “bruxer”  
9 any more than HV Food should have had “the exclusive” to use “ranch.” The  
10 Glidewell website itself is evidence of a dental manufacturer’s commercial need  
11 to use the word “bruxer” to promote products. Glidewell’s own generic use of  
12 the term “bruxer” leads to only one logical conclusion, namely that Glidewell’s  
13 advertising and marketing needed to use the word, just as its competitors do.

14 37. Glidewell’s alleged mark BRUXZIR does not have a sufficient  
15 ambit of protection as a trademark under U.S. law, if any, to claim infringement  
16 by Keating based on Keating’s use of the generic word BRUXER. The word  
17 BRUXER has clear meaning in the relevant industry as being one who suffers  
18 from bruxism (teeth grinding) as evidenced herein. Defendant’s use of  
19 BRUXER identifies the intended user of the goods (a dental crown designed for  
20 or successfully used by people with bruxism, i.e. “bruxers”).

21 38. Glidewell should not have been granted registration for BRUXZIR  
22 (and the Defendant’s cancellation action should be successful) because the  
23 evidence, including Glidewell’s own use, indicates that it is a phonetic  
24 equivalent of the generic term “bruxer.” There is no evidence that the mark is  
25 pronounced or understood by the relevant consumer in any other way. Videos  
26 on Glidewell’s own website reveal that Glidewell itself pronounces (and  
27 promotes pronunciation) of BRUXZIR as being the same as BRUXER. Had  
28 such information been known to the PTO, BRUXZIR would have been denied

1 registration. Under U.S. law, misspellings of words do not extend rights to  
2 otherwise unregistrable marks. Glidewell appears to have relied on the  
3 Examiner's ignorance of the relevant consumer marketplace (dentists and dental  
4 labs) to secure registration.

5 39. The PTO should have inquired as to whether BRUXZIR had any  
6 meaning in the relevant trade; a proper web search for meaning by the  
7 Examining Attorney would have disclosed "bruxer" as having meaning as the  
8 intended user of Glidewell's dental crowns. Had the Examining Attorney  
9 learned of this meaning (of "bruxer") either by search, by making the proper  
10 inquiry, or by Glidewell volunteering such information, Glidewell's application  
11 would then have been refused registration as both "merely descriptive" (initial  
12 refusal) and if on the Supplemental Register or under Section 2(f) of the  
13 Trademark Act, then "generic" (the TMEP recommends one issue refusals in  
14 cases where the mark is so highly descriptive so as to be unable to function as a  
15 mark). In my opinion, had the U.S. Trademark Office properly examined the  
16 case as stated, no registration would have issued.

17 40. Glidewell is asserting a monopoly on the word "bruxer" – a word  
18 used in the dental field many decades before Glidewell first sought registration.  
19 Yet even at the U.S. Trademark Office, a registration dating back to 1989  
20 included "bruxism" in the identification of goods ("dental appliances . . . used  
21 for the treatment of bruxism and temporomandibular joint dysfunctions") under  
22 the mark BRUX-EZE (US Reg. No. 1608966). Keating claims no right to the  
23 word "bruxer" except as the descriptor in its mark as a whole KDZ Bruxer  
24 ("bruxer" disclaimed).

25 41. **"Bruxers" are identified** on the websites of companies which sell  
26 zirconia dental crowns (which are more durable and difficult to chip) – not only  
27 Keating and Glidewell, but other competitors (disclosed in web search entitled  
28 "crowns designed for bruxers" which yielded 96,300 "hits"). The list below is



1 by no means exhaustive:

- 2 a. GPS Dental Lab; (note this company uses the mark BRUX-  
3 ART™ and has filed an application for registration;
- 4 b. Restorative Dental Arts;
- 5 c. Tooth Studio Dental Laboratory; (touts competitive product  
6 Diazir in addition to Glidewell's product, for which it comments  
7 "The chip proof durability of BruxZir is ideal for bruxers. . .");
- 8 d. Cosmetilab Dental Laboratory;
- 9 e. Chameleon Fortress;
- 10 f. Cosmetic Dentistry of San Antonio – website touts: "At  
11 Cosmetic Dentistry of San Antonio we offer the latest in  
12 technology including a patented crown called a "Bruxer"  
13 crown (Bruxism is the habitual grinding of teeth, typically  
14 during sleep and a Bruxer is a person who does this.) This as an  
15 all ceramic, natural looking crown that can be placed on  
16 back teeth.";
- 17 g. Opalite® All-Zirconia Crowns & Bridges advertisement – touts  
18 "Virtually unbreakable, even with severe bruxers"; on the  
19 second page indicates "Every practice has sever bruxers and  
20 grinders that still want an aesthetic posterior restoration;
- 21 h. Second Opalite® All Zirconia Crowns and Bridges  
22 advertisement ("Every practice has severe bruxers and grinders  
23 that still want an esthetic posterior restoration.");
- 24 i. BonaDent Dental Laboratories; ("Perfect for bruxers and  
25 grinders, these shear resistant, all-zirconia crowns are designed.  
26 . .");
- 27 j. Z BRUX CROWNS at Barth Lab; ("Chip resistant quality  
28 makes Z-Brux ideal for bruxers.");



1 k. Showcase Dental Laboratories – previously used the name Zir-  
2 Bruxer Crown but changed it based on “cease and desist”  
3 demand from Glidewell (letter posted on website) – Showcase  
4 notes disagreement with Glidewell’s position but agrees to  
5 change the name in order to concentrate on “customers and their  
6 patients, our quality and our customer services.” Showcase  
7 concludes with “[w]e have hereby changed the name of our  
8 product to reflect the same and product make-up: “Full Contour  
9 Zirconia”.” Apparently, too, Showcase then changes its generic  
10 descriptions to the Zirconia products as “ideal” for “bruxing and  
11 grinding patents” rather than “bruxers and grinders.”

12 42. A search similar to “crowns designed for bruxers” should have  
13 been performed by the Examining Attorney handling the BRUXZIR application.  
14 Such a search would have revealed the third party competitors’ use of “bruxer”  
15 on their websites.. This would have provided the Examining Attorney more  
16 than enough “evidence” that “BRUXZIR” as the legal and phonetic equivalent  
17 of “BRUXZIR” was generic and/or so highly descriptive to not be able to  
18 function as a mark.

19 43. The third party use noted in the previous paragraph is more than  
20 sufficient evidence to justify refusal of registration. In my opinion, the  
21 genericness refusal would have been sustained even by reference to the  
22 Wikipedia article and results found within the first few pages of the “bruxers  
23 teeth” web search. This could include, for example, the LiveStrong  
24 Foundation’s information about “bruxism” which includes reference to  
25 “bruxers” and a “case study” from “The Curious Dentist” about a dentist’s  
26 approach to a dental matter for a “bruxer” patient. In short, this is an “easy”  
27 case to determine and prove for the purpose of sustaining a rejection – “bruxer”  
28 has obvious and easily proven meaning and the subject mark is phonetically

1 equivalent to “bruxer.”

2       44. The U.S. Trademark Office Examining Attorneys are obligated to  
3 follow the Trademark Manual of Examining Procedure (TMEP) when  
4 examining applications. In examining the original application for BRUXZIR,  
5 the Examining Attorney should have asked if the mark had any particular  
6 meaning in relation to the goods or in the relevant trade or industry – and he or  
7 she should have requested additional information about the mark and the goods.  
8 See TMEP Section 814 (“Sometimes, it is necessary for the examining attorney  
9 to request additional information from an applicant in order to examine the  
10 application properly, pursuant to 37 C.F.R. §2.61(b)”). Requesting information  
11 in particularly important when questions of descriptiveness/genericness are “in  
12 play” – see TMEP Section 1209.02 (“The examining attorney must consider the  
13 evidence of record to determine whether a mark is merely descriptive or  
14 whether it is suggestive or arbitrary. See *In re Noble Co.*, 225 USPQ 749, 750  
15 (TTAB 1985). The examining attorney may request that the applicant submit  
16 additional explanation or materials to clarify the meaning of the mark or the  
17 nature of the goods or services.”).

18       45. There is a “checklist” currently used by Examining Attorneys  
19 which become part of the “record” of the examined case. For example, in  
20 Keating’s application for KDZ Bruxer, in which “bruxer” was disclaimed as  
21 generic and for which Keating made no claim as to trademark rights therein, the  
22 file history shows that “Notation to File” was made on June 30, 2011 following  
23 “XSearch Search Summary.” The “XSearch” is the database used by  
24 Examining Attorneys to search the PTO records to make a determination as to  
25 whether any likelihood of confusion refusals must be made. The “Notation to  
26 File” is indicative that “the checklist” followed by the Examining Attorneys  
27 reveals some “activity” – and, in that instance, shows that the Examining  
28 Attorney conducted a web search (using the Google® search engine), an

1 Acronym Finder (because KDZ is the salient portion of the mark, the  
2 Examining Attorney needed to know if it had relevant meaning warranting a  
3 descriptive/generic refusal).

4 46. In the registration file for BRUXZIR, there is no identification of a  
5 “Notation to File” and no indication that a web search or any other follow up  
6 activity was conducted.

7 47. Had the Examining Attorney conducted a web search, he or she  
8 would have seen reference to “bruxer” on Glidewell’s site when he or she  
9 initially examined the application (the specimens of record provided by  
10 Glidewell were in the form of a black and white label), it is very likely the  
11 application would have been refused even without securing additional  
12 information from Glidewell or asking as to relevance in the trade or industry.

13 48. A mark can be held merely descriptive and therefore unregistrable  
14 if it identifies the INTENDED USER of the product just as any other “apt  
15 name” of key product information renders that word generic in relation to the  
16 goods. The TMEP Section on point reads:

17 1209.03(i) Intended Users

18 A term that identifies a group to whom the applicant directs its goods or  
19 services is merely descriptive. See *In re Planalytics, Inc.*, 70 USPQ2d  
20 1453 (TTAB 2004) (GASBUYER merely descriptive of risk management  
21 services in the field of pricing and purchasing natural gas); *Hunter Publ'g*  
22 *Co. v. Caulfield Publ'g Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS  
23 USER found merely descriptive of a trade journal directed toward users of  
24 large data processing systems; evidence sufficient to establish  
25 distinctiveness under §2(f)); *In re Camel Mfg. Co., Inc.*, 222 USPQ  
26 1031 (TTAB 1984) (MOUNTAIN CAMPER held merely descriptive of  
27 retail mail-order services in the field of outdoor equipment and apparel).

28 49. In addition, the “intended user” can still be the basis for a

1 genericness refusal. As noted in TMEP Section 1209.01(c)(iii), CERTIFIED  
2 MORTGAGE BANKER for "educational services, namely providing qualifying  
3 examinations, testing and grading in the field of real estate finance" was held so  
4 highly descriptive as to be incapable of functioning as a mark (equivalent to  
5 genericness and thus unregistrable under any showing of proof). Similarly,  
6 LAWYERS.COM was held generic for "providing an online interactive  
7 database featuring information exchange in the fields of law, legal news and  
8 legal services."

9 50. Examining Attorneys are aware, per TMEP Section 1209.01(c)(i),  
10 that there can be more than one generic term for a particular genus of goods or  
11 services – here bruxer, bruxing, bruxism as well as zirconia, dental, crown, to  
12 name a few, would be generic and would not function as proper marks. That  
13 said, also according to TMEP Section 1209.01(c)(i), any term that the relevant  
14 public understands to refer to the genus is generic; it is not necessary to show  
15 that the relevant public uses the term to refer to the genus – instead, whether the  
16 relevant public would understand the term to be generic is the test. TMEP  
17 Section 1209.01(c)(i), citing *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92  
18 USPQ2d 1682, 1685 (Fed. Cir. 2009).

19 51. On Glidewell's own videos, Glidewell's narrators say both the  
20 word "bruxer" and "Bruxzir" without any difference in pronunciation  
21 whatsoever. Glidewell promotes Bruxzir as indistinguishable from "bruxer."  
22 Moreover, Glidewell uses it as a noun. Proper trademark use requires that in a  
23 grammatical context, a trademark is always an adjective to be modified by the  
24 generic term. In addition, in its promotional videos, Glidewell itself promotes  
25 use of BRUXZIR as a plural noun, suggesting that one could even get "a couple  
26 of Bruxzirs put in" – all indicative of generic use. The Examining Attorney  
27 should have looked to TMEP Section 1209.03(j), which says:

28 A slight misspelling of a word will not turn a descriptive or generic word

1 into a non-descriptive mark. See *C-Thru Ruler Co. v. Needleman*, 190  
2 USPQ 93 (E.D. Pa. 1976) (C-THRU held to be the equivalent of “see-  
3 through” and, therefore, merely descriptive of transparent rulers and  
4 drafting aids); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB  
5 1987) (MINERAL-LYX held generic for mineral licks for feeding  
6 livestock).

7 52. In my opinion, the registration of BRUXZIR should be cancelled  
8 on the basis that the mark is generic and/or so highly descriptive that it cannot  
9 function as a mark.

10 53. I also strongly disagree with Dr. Franklyn’s assertions of a  
11 likelihood of confusion. All competitors making and selling sturdy dental  
12 crowns and related goods have the right to reference “bruxers” – a distinct  
13 intended user and market for their products. In the KDZ BRUXER trademark  
14 application, the word “bruxer” is properly disclaimed as a descriptor. The  
15 Examining Attorney in the KDZ Bruxer application did conduct a search and  
16 determined that BRUXZIR and KDZ Bruxer were not in conflict.

17 54. Both under the *Sleekcraft* factors of the 9th Circuit, and even under  
18 the TMEP from a registration standpoint, the weakness of BRUXZIR cannot be  
19 overstated. Likewise, the only common component between the two is  
20 Keaton’s disclaimed generic word “bruxer.” “Strength of the mark” is the first  
21 factor identified in *Sleekcraft*. As stated in TMEP Section 1207.01(b)(ix), weak  
22 marks are entitled to only narrow protection – even suggesting, as to the most  
23 descriptive, the scope of (merely descriptive, on the Supplement Register)  
24 protection has been limited to the “substantially identical notation.” *In re Hunke*  
25 *& Jochheim*, 185 USPQ 188, 189 (TTAB 1975).

26 55. It is my opinion that “BRUXZIR” is generic and/or so highly  
27 descriptive as to be incapable of functioning as a mark. If BRUXZIR is  
28 afforded any trademark protection, it should be limited to the exact spelling or

1 other misspellings closely resembling it. However, this would not entitle  
2 Glidewell to remove the generic and/or highly descriptive term “bruxer” from  
3 the ordinary trade. Simply stated, one cannot first argue that BRUXZIR is NOT  
4 a misspelling to get past genericness/descriptive hurdles, and then use the  
5 identical pronunciation of “bruxer” for the basis of stealing the generic “bruxer”  
6 from the necessary vernacular of dentists in order to find a likelihood of  
7 confusion.

8 56. BRUXZIR is not the only mark with the root BRUX- at the U.S.  
9 Patent & Trademark Office for the same or closely related goods. The  
10 following are noteworthy:

- 11 a. BRUX-CHECKER owned by Scheu-Dental GmbH for “plastic  
12 foils for use in dental deep-drawing processes (dental  
13 diagnostic); Registered: 2011;
- 14 b. BRUXCURE owned by Richard Horian DBA Bruccure for  
15 “mouth guards for medical purpose”; Registered: 2011;
- 16 c. BRUXGUARD owned by Medtech Products for “dental mouth  
17 guards”; Registered: 1999;
- 18 d. BRUX-EZE owned by Sentage Corp., for “dental appliances ...  
19 used for the treatment of bruxism and temporomandibular joint  
20 dysfunctions”; Registered: 2001;
- 21 e. DR. BRUX owned by Quattrotri Dentech SRL for variety of  
22 dental bite trays, molds, bridges, etc.; Registered: 2010;

23 57. Worthy of note, an anonymous “Letter of Protest” was filed against  
24 the mark BRUX XXX for mouth guards and other devices for diagnosing and  
25 treating “bruxism”. In that Letter of Protest, an anonymous third party informed  
26 the U.S. Trademark Office that the Examining Attorney should have refused  
27 registration for descriptiveness (or if the design alone could “carry” the mark, to  
28 require a disclaimer of “BRUX”) so that the owner, Quattrotri Dentech, also the

1 owner of DR. BRUX above, would effectively hold no rights to “brux” as a  
2 mark. The application was refused until the disclaimer was issued.

3 58. Recently abandoned applications include BRUXOMETER, BRUX  
4 BUSTER CUSTOM NIGHT GUARD (“Brux” disclaimed), and  
5 BRUXQuickSplint, all three of which were abandoned in 2012. Two  
6 applications are pending – GPS BruxArt (noted in third-party users previous)  
7 and BruxThetix.

8 59. It is clear that no single user owns broad rights in the root BRUX,  
9 if any. Certainly Glidewell’s use is further hampered by the fact that the  
10 allegedly noteworthy spelling of ZIR clearly stands for zirconia, the same  
11 materials used by its competitors.

12 60. Glidewell’s mark (if a mark) is very weak, and the only similarity  
13 relates to the “bruxer” portion of Keating’s mark (which is disclaimed and in  
14 which Keating claims no trademark rights); dentists ordering the product are  
15 sophisticated and are not confused (if anything, their alleged confusion stems  
16 from Glidewell’s adoption of a an alleged mark which is phonetically identical  
17 to a generic term that identifies the intended user of the type of products). As  
18 with other competitors, Keating wishes to use “bruxer” to identify the intended  
19 user – as does Glidewell – and this “intent” is mirrored by Glidewell.

20 61. With regard to Professor Franklyn’s Trademark Office Searches  
21 referenced in paragraph 6 of his report, I am unclear as to why such narrow  
22 searches were conducted, as such searches, and the results, provide no genuinely  
23 useful information.

24 62. Moreover, there are clear misstatements in his report. In Paragraph  
25 6, page 6, Professor Franklyn states that his searches show that “bruxer” or  
26 “bruxzir” had not become generic in part because “one would expect for the  
27 term ‘bruxing’ to be observed within the goods and services description for  
28 companies that make crown and bridges in relation to a zirconia brown or



1 bridge. .” In private practice, one attempts to secure as broad rights as possible  
2 for one’s client. To identify (in the description of goods and services) the nature  
3 of the exact treatment only reduces the protection for the client. For example,  
4 neither Keating nor Glidewell wished to restrict their goods identification in that  
5 Glidewell’s registration identification reads “dental bridges; dental caps; dental  
6 crowns; dental inlays; dental onlays; dental prostheses” while Keating’s reads  
7 “dental prostheses.”

8 63. Additionally, while by carefully crafting his searches Professor  
9 Franklyn found no evidence that bruxism or its derivative words had meaning  
10 specifically for zirconia crowns, he stretches to say “rather they were  
11 trademarks for goods related to the treatment of the condition bruxism – namely  
12 devices that measure the patient’s teeth grinding, mouth guards, and electronic  
13 anti-grinding devices. Additionally, none of the trademarks were even remotely  
14 phonetically similar to the term ‘bruxzir’ or ‘bruxer’ other than ‘Bruxometer.’”

15 64. Many things are wrong with this comment. In trademark law and  
16 registration procedure, all goods which work to measure, diagnose or treat  
17 bruxism would be considered “related goods” in the marketplace. Second,  
18 Professor Franklyn appears to be admitting that “bruxzir” and “bruxer” are  
19 phonetic equivalents, yet does not speak to the grand importance of such  
20 admission. In breaking up the searches and not providing a single  
21 comprehensive list, he references only five registrations for BRUX- something,  
22 which are not owned by Glidewell and which are used on dental products  
23 devised for bruxers. Two issued prior to Glidewell’s registration, further  
24 denting Glidewell’s contention of owning broad rights.

25 65. In addition, Professor Franklyn’s manner of searching appears not  
26 to be focused on getting relevant results. I expect that his search for “bruxer  
27 crown” which revealed so few results was searched as the “in exact order”  
28 format. In replicating his search, I get 25 search results. Several of the



1 competitors mentioned previously are listed; Professor Franklyn's dismissal of  
2 each bears more careful scrutiny. He dismissed the Barth Labs' "Z BRUX  
3 CROWNS" because it references an article which, according to Franklyn, was  
4 "largely about Bruxzir" (Glidewell's expert witness continues the practice of  
5 noun usage). He dismisses York Dental's "Bruxer Crown" as being too new.  
6 Yet York sells Glidewell's product and three others, but it uses the "Bruxzir"  
7 mark and also states that it is a "Bruxer" and ideal for "bruxers":

8 **BruxZir** Solid Zirconia is a monolithic solid zirconia restoration with no  
9 porcelain overlay. More brawn than beauty, you'll be impressed by the  
10 esthetics of **Bruxer** when prescribed instead of posterior metal  
11 occlusal PFMs and full-cast metal restorations.

12 **BruxZir** is virtually chip proof, making it the ideal restoration for  
13 bruxers, implant restorations and areas with limited occlusal space.  
14 (Emphasis added)

15 66. Additionally, Professor Franklyn dismisses R-Dent Dental Lab's  
16 "R-Brux Crown" because he found it only on the YouTube video (which I  
17 quoted from). Yet additional information is readily available on the internet,  
18 including an article about R-Dent and the "R-Brux Crown" picked up on  
19 Business Net, an image of the R-Brux crown and a mention in the R-Dent  
20 newsletter from last year as accessed on the R-Dent website.

21 67. The Mascola Esthetics Dental lab, according to Professor Franklyn,  
22 "uses Cercon Zirconia to make the 'Xtreme Bruxer'" but he dismisses it because  
23 "according to the internet archive the page it first appeared May 15, 2011."

24 68. First, this is hardly "proof" that Xtreme Bruxer came after Bruxzir,  
25 but the importance of "coming after" Glidewell's product is negligible. Even if  
26 correct that Glidewell was instrumental in developing the product, this is not a  
27 patent case – this case is about whether Glidewell has the right to prevent  
28 Keating from calling its crowns designed for bruxers a "bruxer" in a generic

1 and/or descriptive fashion. The Mascola mark, like the others in this listing,  
2 plus the many others mentioned in above sections, should have led Professor  
3 Franklyn to conclude that no one "owns" the word bruxer for these or related  
4 goods.

5 69. The final entry of "non-important" competitors identified by  
6 Professor Franklyn is "Showcase Dental" for which he states that "there is no  
7 evidence that the product predated the Bruxzir product as a February 2, 2011  
8 snapshot of their homepage shows that the site was still under construction."  
9 Again, Professor Franklyn seems to misunderstand the importance of the date  
10 (besides his leaps of assumption about them without basis). This is not a  
11 priority race as between two parties in a confusion determination. The  
12 importance is how "bruxer" is viewed by the relevant public, namely, dentists.  
13 In any event, the Showcase website clearly shows, as earlier described, the cease  
14 and desist letter from Glidewell and Showcase's statement that it wished not to  
15 fund such battle.

16 70. In response to Professor Franklyn's statements as to the definition  
17 of a "generic" mark, while not incorrect per se, this case is not pending in the  
18 Second Circuit and several more recent cases on point have been reported since  
19 1963. While I explained above how a mark identifying "intended users" could  
20 be deemed generic, a broader review of what is "generic" or "so highly  
21 descriptive as to be unable to function as a mark" are likewise important:

22 In determining whether a term is generic, we have often relied upon the  
23 "who-are-you/what-are-you" test: "A mark answers the buyer's questions  
24 'Who are you?' 'Where do you come from?' 'Who vouches for you?' But  
25 the [generic] name of the product answers the question 'What are you?'"  
26 *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 (9th Cir. 1993)  
27 (quoting *1 J. Thomas McCarthy, Trademarks and Unfair Competition* §  
28 12.01 (3d ed. 1992)). Under this test, "if the primary significance of the

1 trademark is to describe the type of product rather than the producer, the  
2 trademark [is] a generic term and [cannot be] a valid trademark." *Anti-*  
3 *Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296, 304 (9th Cir.  
4 1979) (emphases added).

5 *Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.*, 198 F.3d  
6 1143, 1146 (9th Cir. 1999).

7 71. In view of the widespread generic and/or highly descriptive use of  
8 "bruxer," and considering that Glidewell itself uses "bruxer" within the  
9 explanation paragraphs of "Bruxzir," it is very much a "what are you?" inquiry.

10 72. I do not understand Professor Franklyn's assessment in Paragraphs  
11 9-12 of his report in which he advises that the relevant goods/services,  
12 consumers, and markets, are the goods/services, consumers and markets of  
13 Glidewell's very specific zirconia products. Certainly Glidewell's products,  
14 markets and customers would be AMONG them but not the exclusive  
15 composition of relevant goods, services, consumers and markets. The most  
16 important of these inquiries is the customers – identified by Glidewell as  
17 dentists, who are sophisticated consumers and are familiar with the term  
18 "bruxer" as a generic reference to patients who suffer from bruxism, and  
19 understand the term "brux" as a reference to the act of "bruxing" or the  
20 condition of "bruxism." Moreover, as Professor Franklyn agrees, dentists also  
21 understand the term "zir" to reference zirconia, commonly used in the  
22 manufacture of crowns for bruxers.

23 73. I disagree with Professor Franklyn's assessment of BRUXZIR as a  
24 suggestive mark. While he correctly identifies the four categories (the 9th and  
25 2nd Circuit do not disagree), to make the statement that BRUXZIR "suggests  
26 some connection between the service of zirconia crown manufacturer for  
27 patients who suffer from 'bruxism'" is quite the understatement when Glidewell  
28 pronounces BRUXZIR and BRUXER as one and the same. It does not matter at

1 all that not ALL Bruxzir patients are bruxers, as offered by Franklyn. His  
2 analysis in Paragraph 14 appears to say that the genus of actual goods here  
3 would be “zirconia crowns” but he is ignoring the law – and common sense. As  
4 described in the TMEP Section 1209.01(c)(ii):

5 The expression "generic name for the goods or services" is not limited to  
6 noun forms but also includes "generic adjectives," that is, adjectives that  
7 refer to a genus, species, category or class of goods or services. *In re*  
8 *Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991)  
9 (PERMA PRESS generic for soil and stain removers for use on  
10 permanent press products).

11 74. I emphatically disagree with Paragraph 16 of Professor Franklyn’s  
12 conclusions – namely that “there is no phonetic equivalence because Bruxzir has  
13 a distinct Z sound not present in bruxer.” I implore the Court to listen to the  
14 Glidewell videos – and, to use common sense, most words with an internal “x”  
15 have “z” sounds (e.g. Dictionary.com identifies pronunciation for “Alexander”  
16 as “al-ig-zan-der” and “example” as “ig-zam-puhl”).

17 75. His second argument is that the mark “cannot be judged solely on  
18 its phonetic (audible) meaning or connotation” and cites case law that one must  
19 look at “sight, sound and meaning”. Unfortunately, he misunderstands the law  
20 he cites. The reference in *In Re National Data* relates to not dissecting a mark  
21 relates to likelihood of confusion, not genericness (“[t]he basic principle in  
22 determining confusion between marks is that marks must be compared in their  
23 entireties . . .”). It a tenet of trademark law in the context of descriptiveness or  
24 genericness that if a mark which bears a misspelling AND which is phonetically  
25 identical to an otherwise descriptive or generic mark, it is considered a “legal  
26 equivalent” and will be treated the same as would the ordinary spelling. *See In*  
27 *Re State Chemical Manufacturing Co.*, 225 USPQ 687 (TTAB 1985) in which  
28 FOM (in the format of “bubble” letters) for carpet shampoo was held to be the

1 legal equivalent of the word “foam” despite the differences in appearance and  
2 spelling. Referencing prior cases in which marks were deemed the legal  
3 equivalents for the generic word, namely TINTZ for tints, ALKOL for alcohol,  
4 LITE for light, and SAVON GAS for “save on gas” (at 689), the Board noted  
5 that despite Applicant’s acknowledgement that it “could not interfere with  
6 anyone’s right to use ‘foam’ to describe the foaming characteristic of its rug  
7 shampoo” based on a registration for FOM (in bubble letters), the Board refused  
8 registration nonetheless, stating the law required it so as to not “place one in a  
9 position to make or threaten to make an unwarranted claim of rights based on  
10 the presumptive right to exclude another’s use which flows from the grant” of a  
11 registration.” 225 USPQ at 690.

12 76. In this case, Glidewell is doing exactly what the Board so carefully  
13 guarded against.

14 77. Regarding Professor Franklyn’s claim that he found “no use of”  
15 dentists using “Bruxzir” as a “slang term” and like statements, my response is  
16 that it is easy to ask the wrong questions and find no answers. In Paragraph 18  
17 of his report, he states that even if dentists perceived “Bruxzir as the phonetic  
18 equivalent of Bruxzir,” that would “not render Bruxzir a generic mark.” First, it  
19 seems that the typist misheard the second “bruxer” as “Bruxzir.” Putting that  
20 aside, Professor Franklyn again wrongly concludes that “to be rendered generic,  
21 it would have to be shown that dentists predominantly view Bruxzir as the name  
22 for either the service of making solid zirconia crowns or for the material that is  
23 used to make those crowns.” Previous legal citations show this to be incorrect –  
24 if Professor Franklyn were correct, then I would be free to register the mark  
25 CROWN DESIGNED FOR BRUXERS, BRUXER CROWN, CROWN FOR  
26 TEETH GRINDERS and the like.

27 78. In Paragraph 19, Professor Franklyn declares that he found “no use  
28 of the words “Bruxzir” or “bruxer” as the generic name of either custom-made

1 solid zirconia crowns or as the generic name of the material that is used to make  
2 such crowns” and cites his search of US Trademark Office records. First, the  
3 Trademark Office records are wholly inadequate for this purpose as described  
4 previously. Second, he again is misusing or misunderstanding what genericness  
5 entails. I can attest to having found evidence of numerous third-parties which  
6 use “bruxer” to refer to the intended user of the crown regardless of the material  
7 from which it is made. I also found evidence of use of “Bruxzir” which used the  
8 mark as a noun, made it into a plural to connote more than one unit, and several  
9 dental labs and dentists who seemed not to know when to use “Bruxzir” and  
10 when to use “bruxer” even when describing Glidewell’s product.

11 79. I wholly disagree with Paragraph 20 and 21 as stated by Professor  
12 Franklyn. Under no viable application of facts to law or law to facts would  
13 anyone consider Bruxzir to be “a strong mark”. His reference to this being so  
14 “from a market penetration perspective” (in addition, he claims, to a linguistic  
15 perspective) is nonsensical. I opine, based on the above evidence and my  
16 understanding from the many years of practicing trademark law, that BRUXZIR  
17 is a generic term (so highly descriptive as to be unable to function as a mark); if  
18 it were to have developed any trademark rights (generic marks by their nature  
19 cannot “acquire distinctiveness from use and advertising) it would have been  
20 narrowly limited to a unique spelling and pronunciation (“Brux-zeer” not unlike  
21 the Seinfeld episode “manzier/mansierre”). Glidewell’s own pronunciation  
22 (which is identical to “bruxer”) eliminated any prospect of gaining rights based  
23 on acquired distinctiveness/secondary meaning. Likewise, the Professor’s  
24 accounting of this allegedly “wide recognition” by relevant consumers  
25 undoubtedly includes those who choose the new zirconia crowns which are  
26 “good for” bruxers, as established by the advertising and web results. Nothing  
27 offered by Professor Franklyn suggests that Glidewell has established any  
28 secondary meaning.

1           80. In regards to Paragraph 22, and the notion of market strength, his  
2 reference to Google® as a mark is dubious – Google is an arbitrary mark.  
3 Additionally, Google (the company) faces trademark problems with its Google  
4 brand for the reason that it oft-used as a verb (“go Google that for me”) and  
5 currently faces a federal court suit in which genericide is asserted. Additionally,  
6 it is noted that Professor Franklyn has referenced that in his Google searches  
7 that “Bruxzir” would be autocorrected when he attempted to search “bruxer.”  
8 Note that this is of little consequence as the auto-correct feature is based in part  
9 on one’s search history (if one searches “Bruxzir” many times it will be  
10 “suggested”) and possibly on Glidewell’s purchase of AdWords.

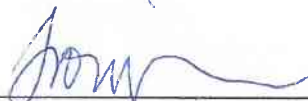
11           81. In Paragraph 24 of his report, Professor Franklyn claims that  
12 dentists may be confused as to affiliation “between Bruxzir and KDZ Bruxer”  
13 despite their sophistication as customers. He purposely references “KDZ” as a  
14 prefix when it is the salient portion of the mark – of the family of KDZ marks.  
15 On Keating’s website the left toggle references the bruxer product as “KDZ®  
16 Bruxer.” Additionally, Keating own two other “KDZ” mark registrations are  
17 listed. Without reviewing alleged evidence of actual confusion, any alleged  
18 confusion most likely relates to Glidewell’s attempt to monopolize a necessary  
19 and often used generic and/or highly descriptive word, namely bruxer.

20           82. In reviewing this case, I draw on all my professional experience  
21 from inside and outside the U.S. Trademark Office. I have respect for Professor  
22 Franklyn’s academic credentials but note that in conducting an “attorney of  
23 record” search at the U.S.P.T.O. database, I can’t help but comment that he has  
24 prosecuted three applications, only one of which matured to registration and is  
25 still active. This is not to cast aspersions on his knowledge of the law, but I  
26 would suggest that the application of law in this instance is the more difficult  
27 task. In my opinion, confusion is unlikely to result between KDZ Bruxer and  
28 BRUXZIR – and if there is confusion, it is based on the unusual character of a



1 mark which is the phonetic equivalent of a common term in dentistry, bruxer.  
2 This case appears to be a genuine example of one who wrongly takes a dubious  
3 registration and attempts to wrest the generic term from all its competitors. A  
4 trademark is, above all else, an identifier of source, a designation for the public  
5 to distinguish one product from the next. While Professor Franklyn finds fault  
6 with Keating's adoption of KDZ Bruxer (inexplicably that even a "Z" in the  
7 three letter acronym is somehow indicative of bad intent), the clear bad actor  
8 here is, in my opinion, Glidewell, who is waging competitive war against its  
9 market challengers by usurping a generic term. While many companies are now  
10 making similar products, Glidewell's intention appears to keep all of them from  
11 being able to explain the best possible use for the products, namely that the  
12 primary intended users are, indeed, bruxers. Certainly if any company could go  
13 without referencing bruxers in advertisements, Glidewell should be doing so at  
14 this time to help its case – but it is not. Bruxers are those in need of zirconia  
15 crowns, and dentists want to properly treat such patients. In many respects, this  
16 case is not about trademarks at all - since Glidewell is no longer the only maker  
17 of bruxer crowns and is losing market share to competing products. In my  
18 opinion, Glidewell's registration should be cancelled as it is behaving in the  
19 exact fashion feared by the U.S. Trademark Office TTAB in *In Re State*  
20 *Chemical Manufacturing Co.* cited above.

21 Dated: October 15, 2012

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Lori N. Boatright



# EXHIBIT A

**LORI N. BOATRIGHT**

lori\_boatright@bstz.com  
(310) 351-9344

**EXPERIENCE**

**BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP**

Los Angeles, CA  
1988 - Present

Chair, Trademark Practice Group, 1996 – Present

Management Committee Member, 2002-2006; 2009-2010

Strategic Planning Committee, Chair, 2001 Present

Partner, 1993 – Present

Associate Attorney, 1988 – 1993

Practice all aspects of trademarks and unfair competition, including publicity rights, emerging issues surrounding social media and advertising. Focuses significantly on branding-related transactional work and client counseling – including providing advice during selection and clearance, during filing and prosecution (domestic and international), and in providing overall protection strategies. Branding analysis, growth and management of domestic and international trademark portfolios, enforcing rights in proceedings at TTAB and in Federal Court.

**U.S. PATENT AND TRADEMARK OFFICE**

Arlington, VA  
January 1987- November 1988

*Trademark Examining Attorney*

Examine trademark and service mark applications for suitability for trademark registration; review for substantive and administrative legal issues; conduct trademark and service mark searches; prepare legal arguments in formal Office Actions following determination; prepare appeals and conduct oral argument at Trademark Trial and Appeal Board (TTAB); selected for TTAB assignment.

**OFFICES OF FRED KUGLER**

Arlington, VA  
August 1985 – January 1987

*Attorney*

Conduct and analyze trademark searches; review and analyze comprehensive searches; update in-house common law information; prepare trademark availability opinions.

**CARSON COIL RILEY & McMILLIN**

Jefferson City, MO  
August 1984 – July 1985

*Associate Attorney*

Practice in general civil litigation and represent criminal defendants in state court including felonies; lead attorney in dozens of bench trials and one jury trial; second chair in complex litigation; conduct discovery; prepare cases for trial; negotiate disputes in automobile accidents, family law, and general business

**PROFESSOR WILLIAM KNOX**

Columbia, MO

**(LATER U.S. DISTRICT COURT, WESTERN DISTRICT OF MISSOURI)**

1983-84

*Assistant/Legal Clerk*

Conduct legal research; write memos

**STATE PUBLIC DEFENDER, APPELLATE DIVISION**

Columbia, MO

1982-84

*Law Clerk*

Review trial transcripts and prepare legal argument in support of appeal

**TURNER REID DUNCAN & LOOMER**

Springfield, MO

*Law Clerk* – Summers 1982, 1983

*Investigator* – 1978 – 1981

**EDUCATION**

**UNIVERSITY OF MISSOURI SCHOOL OF LAW**

Columbia, MO

J.D., May 1984

Board of Advocates: Director (1983-4), Member (1982-83)

National Moot Court – Regional Team Fall 1982, Fall 1983

Women's Law Caucus Vice President

Law Class Prize for Advocacy (Deacy Annual Award), 1984

Order of the Barristers

**MISSOURI STATE UNIVERSITY**

Springfield, MO

B.A., *Summa Cum Laude*, December 1980

Writing Major/Political Science Minor

Regents Academic Scholarship, 1977-1980;

Student Senate, 1977-1980; Writing Prize; Resident Assistant

**LECTURES AND WRITINGS**

Featured lecturer on trademark matters at professional, academic and business forums, including:

Santa Clara University School of Law, Summer LLM Program Development for Foreign Scholars and Intellectual Property – Trademark Law; participation in strategy sessions, develop coursework, prepare syllabus in conjunction with tenured faculty/committee to establish program and serve as adjunct faculty, 2010 – (POSTPONED)  
Santa Clara, CA

Technology Consortium; Lecturer/Leader – Marketing and Branding, 2004, 2008, 2009  
San Francisco, CA  
Silicon Valley/San Jose, CA

Beverly Hills Bar Association; Panelist – Legal Updates: Trademark Law, 2005  
Beverly Hills, CA

Entertainment Law Firm Forums; Featured Speaker – Publicity Rights and Trademark Issues, 2005, 2009  
Los Angeles, CA

State Bar of Oregon; Featured Speaker – Domain and Cybersquatting Strategies, 2004  
Portland, OR

*Appeal Practice in Ex Parte cases* (Book Series Chapter); Intellectual Property Course Handbook Series/Trademark Rules and Practice, 2003

Practicing Law Institute; Lecturer/Panelist – Navigating Trademark Trial & Appeal Board Practice, 2003

San Francisco, CA

University of Minnesota School of Law – Oral Argument Presentation following Session of Court of Appeals Federal Circuit, 2001  
Minneapolis, MN

U.S. Patent & Trademark Office/Continuing Legal Education, Trademark Trial and Appeal Board Special Series; 2000  
Arlington, VA

U.S. Patent & Trademark Office, Special Lecture on Outside Bar Perspectives for Trademark Examining Attorney Corp; 1996  
Arlington, VA

U.S. Patent & Trademark Office, Featured Lecturer, Legal Education Series on Trademark Licensing for Trademark Examining Attorney Corp; 1990  
Arlington, VA

Beverly Hills Bar Journal, “*The Trademark Law Revision Act of 1988: A New Era*” (with N. Zafman); 1988

### **RECOGNITION**

*World Trademark Review – World’s Leading Trademark Professionals*; 2009 – Present  
Special Recognition: *Prosecution and Strategy*

*Who's Who: Legal for Trademarks*; 2008 – Present

*Who's Who Executives and Professionals Throughout the World*; 2009 – Present

*Corporate Counsel Guide to California Lawyers and Law Firms*

*NameProtect Trademark Insider® Awards for National Top Ten Trademark Practice and Best Regional Firm* (multiple years)

### **AFFILIATIONS**

International Trademark Association; American Bar Association; California Bar Association; Missouri Bar Association

### **BAR AND COURT ADMISSIONS**

Admitted to California State Bar, May 1989

Admitted to Missouri Bar, August 1984

U.S. District Court, Central and Southern Districts of California; Court of Appeals for the Federal Circuit

### **REPRESENTATIVE CLIENTS**

Patagonia, Inc.; Brooks Running; Nature Made/Pharmavite; HDMI Licensing; Accuray CyberKnife; Silicon Image, Inc.; Celebrity Clientele (film/television actors, directors, production companies, musicians, comedians, authors, entertainers, and sports figures)

### **HIGHLIGHTED PROJECTS**

Provided strategic trademark counsel to Intel Corporation for “*INTEL INSIDE®*” branding and marketing launch, 1990-1993;

Provided strategic trademark counsel to Apple Inc. for “*i-*” formative marks and branding initiative; support as to clearance, analysis, branding advice to Senior Attorney, Trademarks, 1998-2001.

**EXPERT WITNESS CASES**

Optimal Pets, Inc. v. Nutri-Vet, LLC et al., EDCV 08-1795 SGL (C.D. Cal. 2008)

Artists Management Group, LLC v. Advantage Marketing Group, Inc., CV-01-4890 (C.D. Cal. 2001)

SG Services, Inc. v. God's Girls, LLC, CV01526 (OR-Portland 2005) ; and

SG Services, Inc. v. God's Girls, LLC, 2:08-CV-01873-ODW-JWJ (C.D. Cal. 2008)

**PROOF OF SERVICE**

I am a citizen of the United States of America and I am employed in Irvine, California. I am over the age of 18 and not a party to the within action. My business address is 2040 Main Street, Fourteenth Floor, Irvine, California. I am readily familiar with the firm's business practices for the collection and processing of correspondence for mailing, and that mail so processed will be deposited the same day during the ordinary course of business.

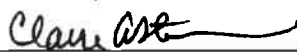
On October 15, 2012, I caused the within LORI BOATRIGHT'S EXPERT REBUTTAL REPORT TO THE REPORT OF DAVID J. FRANKLYN to be served on the parties or their counsel shown below, by placing it in a sealed envelope addressed as follows:

***Via Electronic and First Class Mail:***

Leonard Tachner, Esq.  
LEONARD TACHNER, A Professional Law Corp.  
17961 Sky Park Circle, Suite 38-E  
Irvine, CA 92614-6364  
Email: ltachner@aol.com

I declare that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on October 15, 2012 at Irvine, California.

  
\_\_\_\_\_  
Claire A. Stoneman

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